

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 3

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Filed
October 24, 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

GEORGE J. STEPNIEWSKI
Junior Party
(U.S. Patent 5,648,066)

OCT 24 2001
PAT. & T M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

v.

PASCAL ARNAUD AND MYRIAM MELLUL
Senior Party,
(U.S. Application 09/049,927).

Patent Interference No. 104,751

COMMUNICATION

Among the issues to be discussed during the conference call scheduled for December 19, 2001, is Arnaud's written descriptive support for its broadly claimed "non-volatile silicone fluid." On or before **December 17, 2001**, the parties are invited to submit written comments regarding Arnaud's compliance with the written description requirement for its claimed silicone fluid.

The purpose of the written description requirement is to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later

claimed by the inventor. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116.

The inventor can demonstrate possession by such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention. The inventor, however, needs to show that the inventor was "in possession" of the invention by describing the invention, with all its claimed limitations, not that which makes it obvious. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

The disclosure as originally filed does not have to provide *ipsis verbis* support for the claimed subject matter at issue. *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323, 56 USPQ2d 1481, 1483 (Fed. Cir. 2000); *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1570, 39 USPQ2d 1895, 1904 (Fed. Cir. 1996). Rather, if the written description does not use precisely the same terms used in a claim, the question then is whether the specification directs or guides one skilled in the art to the subject matter claimed such that the specification reasonably conveys to those skilled in the art that the inventor invented what is claimed. See, e.g., *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1570, 39 USPQ2d 1895, 1904 (Fed. Cir. 1996); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116; *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989).

Additionally, claims may be no broader than the supporting disclosure. As stated in *Gentry Gallery*:

In sum, the cases on which Gentry relies do not stand for the proposition that an applicant can broaden his claims to the extent that they are effectively bounded only by the prior art. Rather, they make clear that claims may be no broader than the supporting disclosure, and therefore that a narrow disclosure will limit claim breadth.

Gentry Gallery, Inc. v. Berkline Corp., 134 F.3d 1473, 1480, 45 USPQ2d 1498, 1503 (Fed. Cir. 1998).

Arnaud's pending claims 13-37 are said to correspond exactly or substantially to all the claims of Stepniewski, U.S. Patent 5,648,066. (U.S. Application 09/049,927, Preliminary Amendment, Paper No. 3, p. 6). Specifically, Arnaud's claims are directed to solid silicone compositions and methods for preparing such compositions. Independent claim 13 is representative of Arnaud's compositions claims and reads as follows:

13. A solid silicone composition suitable for topical application to human skin or hair which comprises:

- (a) from about 3 to about 30 percent by weight of the total composition of a polyethylene solidifying agent which is a straight-chain homopolymer of polyethylene having an average molecular weight of about 500 or less as measured by vapor pressure osmometry; and
- (b) from about 10 to about 97 percent by weight of the total composition of a *non-volatile silicone fluid*.

(Emphasis added). Arnaud's method claim, claim 30, is generally directed to methods of preparing compositions such as those recited in claim 13.

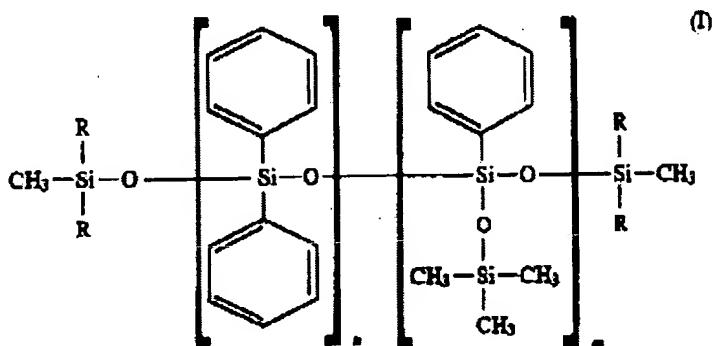
Arnaud's application discloses that:

After a great amount of research it has now been found, surprisingly and unexpectedly, that, by combining a *particular silicone oil* and a wax made from an ethylene homopolymer or copolymer, the choice of which was based both on the melting point and on the molecular mass, it was possible to produce silicone oil-based, homogeneous anhydrous cosmetic compositions, without being limited by a restrictive range of proportions.

(Arnaud Application 09/049,927, p. 2, lines 16-22, emphasis added). Moreover, Arnaud discloses that the "present invention" concerns a silicone oil-based cosmetic having a

homogeneous fatty phase characterized by the fact that the fatty phase incorporates a mixture comprising a particular wax and:

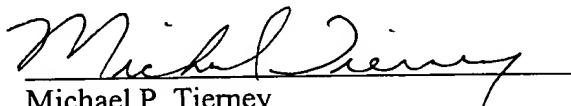
(i) at least one silicone oil in a proportion of 5 to 97% by weight of said fatty phase *and corresponding to the following formula:*



wherein R represents alkyl containing 1 to 30 carbon atoms, aryl or aralkyl, n represents a whole number between 0 and 100, and m represents a whole number between 0 and 100, provided that the sum n+m is between 1 and 100.

(Arnaud Application 09/049,927, p. 3, lines 3-19, emphasis added).

It is unclear whether Arnaud's disclosure of a "particular" silicone oil reasonably conveys to those skilled in the art that Arnaud invented solid silicone compositions comprising a particular polyethylene solidifying agent in combination with an unspecified "non-volatile silicone fluid." Accordingly, the parties are invited to provide written comments regarding Arnaud's guidance, or lack thereof, for the presently claimed invention.



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Date: October 23, 2001
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